

REMARKS

This is a fully and timely response to the non-final Office Action of October 1, 2004. Reconsideration of the application in light of the forgoing amendments and the following remarks is respectfully requested.

In the present paper, various claims are amended. New claims 60-63 have been added. No claims are cancelled by this paper. Claims 47 and 59 were cancelled previously. Therefore, Claims 1-46, 48-58 and 60-63 are currently pending for the Examiner's consideration.

With regard to the prior art, the final Office Action rejected claims 23-25, 27, 30, 31, 35, 37, 40, 42, 47, 48, 49, 51-53 and 55-58 as anticipated under 35 U.S.C. § 102(e) by U.S. Patent No. 6,678,463 to Pierre et al. ("Pierre"). Dependent claims 26, 29, 32, 33, 34, 36, 41, 50 and 51 were rejected as unpatentable under 35 U.S.C. § 103(a) in view of the combined teachings of Pierre and U.S. Patent No. 6,311,011 to Kuroda. Claim 33 was further rejected under § 103(a) over the combined teachings of Pierre and U.S. Patent No. 5,990,881 to Inoue et al. Dependent claims 38, 39, 43 and 54 were rejected as unpatentable under 35 U.S.C. § 103(a) in view of the combined teachings of Pierre and U.S. Patent No. 6,642,939 to Vallone et al. For at least the following reasons, these rejections are respectfully traversed.

Independent claim 23, as amended herein, recites:

A personal video recorder comprising:  
an input for receiving an audiovisual signal and an output for outputting said audiovisual signal;  
a buffer for buffering said audiovisual signal, said buffer retaining a portion of said audiovisual signal after that portion has been output by said recorder;  
a data storage unit; and  
a processor that receives input from a user input device;

wherein, upon receipt of a user command input through said user input device, said processor automatically records a segment of said audiovisual signal in said data storage unit, said segment of said audiovisual signal comprising:

a first predetermined amount of said portion of said audiovisual signal retained in said buffer; and

a second predetermined amount of said portion of said audiovisual signal output by said recorder after receipt of said user command;

wherein said user input device receives parameters from a user that specify said first and second predetermined amounts, said processor then receives said parameters and automatically records said segment based on said parameters. (emphasis added).

In contrast, Pierre does not teach or suggest the claimed recorder in which a user inputs specific parameters that specify a first and second amount of a segment to be recorded, where the recorder then automatically records the desired segment based on the input parameters. Support for claim 23 can be found in Applicant's specification as originally filed, at, for example, page 12, lines 3-13, which reads:

Additionally, the PVR of the present invention may allow the user to specify the amount of running time a captured clip should contain (403). For example, the user may pre-set the PVR to record 10 seconds preceding receipt of the "bookmark" command and 10 second following to constitute a captured clip. Alternatively, the running time recorded before and after the "bookmark" command need not be the same. For example, user may pre-set the PVR to record 5 seconds preceding receipt of the "bookmark" command and 15 second following to constitute a captured clip. Entry of this parameter can be performed using the remote control unit (106) or other user data entry device connected to the PVR (101).

Claims 51 and 55 recite similar subject matter

"A claim is anticipated [under 35 U.S.C. § 102] only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987) (emphasis added). *See* M.P.E.P. § 2131. Therefore, the rejection of claims 23-29, 51 and 55 based on Pierre should be reconsidered and withdrawn.

Claim 30 recites:

A personal video recorder comprising:  
 an input for receiving an audiovisual signal and an output for outputting said audiovisual signal;  
 a buffer for buffering said audiovisual signal, said buffer retaining a portion of said audiovisual signal after that portion has been output by said recorder;  
 a data storage unit; and  
 a processor that receives input from a user input device;  
 wherein, upon receipt of a user command input through said user input device, said processor records a segment of said audiovisual signal in said data storage unit, said segment of said audiovisual signal comprising:  
 a first predetermined amount of said portion of said audiovisual signal retained in said buffer; and  
 a second predetermined amount of said portion of said audiovisual signal output by said recorder after receipt of said user command; and  
 wherein said processor associates an identifying label with each said segment of said audiovisual signal recorded in said data storage unit such that segments taken from a single audiovisual program can be distinguished.  
 (emphasis added).

Claims 52 and 56 recites similar subject matter.

In contrast, Pierre merely teaches that “The storage device 18 typically contains a plurality of programs which have been recorded by a viewer. The recordings are associated with identifying information that may have been copied or modified from the signaling information.” (Col. 5, lines 51-55). Thus, Pierre only teaches associating identifying information with completed recordings of an entire program. Pierre does not teach or suggest the claimed associating of “an identifying label with each said *segment* of said audiovisual signal recorded in said data storage unit *such that segments taken from a single audiovisual program can be distinguished*.”

The recent Office Action fails to respond to or even address this point made previously by Applicant. The Office Action on page 11 states that “Pierre teaches each segment (file) having a label that distinguishes from other taken from a movie program or show.” This is not, however, a statement of what Applicant is claiming. The Action does not address the claimed situation in which segments taken from a *single* program are labeled so as

to be distinguished. Nowhere does Pierre teach or suggest such subject matter. The Office Action further fails to indicate how or where Pierre teaches such subject matter, or to even clearly allege that the claimed subject matter is taught by Pierre. Therefore, for at least these reasons, the rejection of claims 30-41, 52 and 56 based on Pierre should be reconsidered and withdrawn.

Claim 42, as amended herein, recites:

A personal video recorder comprising:  
an input for receiving an audiovisual signal and an output for outputting said audiovisual signal;  
a buffer for buffering said audiovisual signal, said buffer retaining a portion of said audiovisual signal after that portion has been output by said recorder;  
a data storage unit; and  
a processor that receives input from a user input device;  
wherein, upon receipt of a user command input through said user input device, said processor records a segment of said audiovisual signal in said data storage unit, said segment of said audiovisual signal comprising:  
a first predetermined amount of said portion of said audiovisual signal retained in said buffer; and  
a second predetermined amount of said portion of said audiovisual signal output by said recorder after receipt of said user command;  
wherein said user input device comprises a remote control unit having a dedicated button for issuing said user command to record said segment of said audiovisual signal such that, upon actuation of said dedicated button, said processor records said first predetermined amount in said data storage unit and records said second predetermined amount in said data storage unit and then automatically stops recording having captured said segment.  
(emphasis added).

Claims 53 and 54 recite similar subject matter.

In contrast, the cited prior art fails to teach or suggest the claimed dedicated button for issuing a user command to record a segment of audiovisual signal where, “upon actuation of said dedicated button, said processor records said first predetermined amount in said data storage unit and records said second predetermined amount in said data storage unit and then

automatically stops recording having captured said segment.” Consequently, the rejection of claims 42-46, 48-50, 53 and 54 based on Pierre should be reconsidered and withdrawn.

Claim 57 recites:

A method of operating a personal video recorder that processes an audiovisual signal and selectively records said audiovisual signal in a data storage unit, said method comprising:

retrieving an audiovisual program stored on said data storage unit in said recorder;

outputting said audiovisual program to playback that recorded audiovisual program;

receiving a user command through a user input device; and,

in response to said user command, storing a separate recording of a segment of said audiovisual program that is being played from said data storage unit, said segment comprising a first predetermined amount of said audiovisual program output prior to receipt of said user command and a second predetermined amount of said audiovisual program output after receipt of said user command.

Applicant previously pointed out that claim 57 recites playback of an audiovisual program that is already stored on the data storage unit of the PVR and then capturing segments of that program during playback based on user commands and storing separate recordings of the captured segments. In contrast, Pierre only teaches a method of recording broadcast programs that are being received from a broadcast station (12).

In response, the recent Office Action incorrectly states that claim 57 does not clearly recite capturing a segment of a program that is being replayed from the PVR storage unit. (Office Action 10/1/04, p. 12). This is clearly incorrect as claim 57 recited making a “separate recording” of a segment of the audiovisual program already recorded and being played back. However, Applicant has amended claim 57 herein to inescapably recite that the segment is captured from a program that is already recorded and is being played back. These amendment, however, are not intended and do not alter or narrow the scope of the claim

Pierre does not teach or suggest a method of capturing segments of a program that is being replayed from a PVR's own data storage unit as recited in claim 57. Consequently, the rejection of claims 57 and 58 based on Pierre should be reconsidered and withdrawn.

Claim 28 was rejected as being unpatentable under 35 U.S.C. § 103(a) over the combined teachings of Pierre and U.S. Patent No. 5,237,462 to Jo ("Jo"). For at least the following reasons, this rejection is respectfully traversed.

Claim 28 has been amended herein and rewritten as an independent claim. Claim 28 now recites:

A personal video recorder comprising:  
an input for receiving an audiovisual signal and an output for outputting said audiovisual signal;  
a buffer for buffering said audiovisual signal, said buffer retaining a portion of said audiovisual signal after that portion has been output by said recorder;  
a data storage unit; and  
a processor that receives input from a user input device;  
wherein, upon receipt of a user command input through said user input device, said processor automatically records a segment of said audiovisual signal in said data storage unit, said segment of said audiovisual signal comprising:  
a first predetermined amount of said portion of said audiovisual signal retained in said buffer; and  
a second predetermined amount of said portion of said audiovisual signal output by said recorder after receipt of said user command, wherein said second predetermined amount is determined by a length of time during which a user holds down a button on said user input device for issuing said user command.

Newly added claims 60-63 depend from claim 28 and are thought to be patentable for the same reasons given below with respect to claim 28.

The combination of Pierre and Jo fails to teach or suggest a recorder, as claimed, in which a user indicates the desired length of a captured video segment by taking a predetermined amount from a buffer and a second predetermined amount of subsequent video

indicated by the length of time a user holds down a button on a user input device for issuing a video capture command.

"To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974)." M.P.E.P. § 2143.03. Accord. M.P.E.P. § 706.02(j). For at least this reason, the rejection of claim 28 should be reconsidered and withdrawn.

Claims 1-3, 5, 9, 11-13, 17-18, 15, 21 and 22 were rejected under 35 U.S.C. § 103(a) over the combined teachings of Pierre and U.S. Patent No. 5,438,423 to Lynch et al. ("Lynch"). Dependent claims 4 and 10 were rejected under 35 U.S.C. § 103(a) over the combined teachings of Pierre, Lynch and Kuroda. Claims 6, 7, 14 and 20 were rejected under 35 U.S.C. § 103(a) over the combined teachings of Pierre, Lynch and Vallone. Claims 9 and 16 were rejected as unpatentable under 35 U.S.C. § 103(a) over the combined teachings of Pierre, Lynch and Jo. For at least the following reasons, these rejections are also respectfully traversed.

Claim 1 recites:

A personal video recorder having a user-controlled data capture function, the recorder comprising:

an input for receiving an audiovisual signal and an output for outputting said audiovisual signal;

a buffer for buffering said audiovisual signal, said buffer retaining a portion of said audiovisual signal after that portion has been output by said recorder;

a data storage unit; and

a processor that receives input from a user input device;

wherein, upon receipt of a user command input through said user input device, said processor records a segment of said audiovisual signal in said data storage unit, said segment of said audiovisual signal comprising:

a first predetermined amount of said portion of said audiovisual signal retained in said buffer, wherein said first predetermined amount is less than all of said portion of said audiovisual signal retained in said buffer; and

a second predetermined amount of said portion of said audiovisual signal output by said recorder after receipt of said user command.

Independent claims 11 and 17 recite similar subject matter.

According to the recent Office Action, Pierre fails to teach or suggest that less than all of the audiovisual signal retained in the buffer is moved for storage in the data storage unit in response to a user command. According to the Office Action, however, Lynch teaches this subject matter in col. 3.

Applicant has previously pointed out that col. 3 of Lynch does not actually teach or suggest less than all of a portion of an audiovisual signal stored in a buffer being moved to a data storage unit. In response, the recent Office Action merely reiterates the unsupported conclusion that Lynch teaches such subject matter. The recent Office Action contains no further analysis, no citations or quotes from Lynch that support the rejection of these claims. Consequently, the Action fails to make out a prima facie case of unpatentability with regard to claims 1, 11 and 17, and their dependent claims.

Applicant has actually reviewed col. 3 of Lynch. In pertinent part, col. 3 of Lynch reads:

If the viewer wishes to save a portion of the video program, a save command may be used to cause a segment, either of fixed or variable duration, of the video program to be transferred to the static buffer 22, which may be a reserved portion of the dynamic buffer 16 as determined by the viewer. The use of a portion of the dynamic buffer 16 as the static buffer 22 reduces the amount of video program material available to the viewer at any one time. The saved video from the static buffer 22 may be viewed upon command at any desired rate, realtime, slow motion or fast forward, and in either direction, forward or reverse. If permanent saving is desired, the video from the static buffer 22 may be transferred to the VCR 24. Of course the video from the dynamic buffer 16 may also be transferred to the VCR 24 directly rather than being buffered by the static buffer 22.

(Col. 3, lines 22-38).

Nowhere does Lynch teach or suggest that less than all the contents of the dynamic buffer are transferred to the static buffer when a save command is received. Lynch simply



does not teach or suggest a buffer of constant size where less than all the contents of the buffer are saved in response to a user command as claimed.

"To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974)." M.P.E.P. § 2143.03. Accord. M.P.E.P. § 706.02(j). Moreover, it is incumbent upon the Examiner to identify where in the reference each element may be found. *Ex parte Levy*, 17 U.S.P.Q.2d 1461 (BPAI 1990). Therefore, the rejection of claims 1-22 based on the combination of Pierre and Lynch is deficient and unsupported and should be reconsidered and withdrawn.

For the foregoing reasons, the present application is thought to be clearly in condition for allowance. Accordingly, favorable reconsideration of the application in light of these remarks is courteously solicited. If any fees are owed in connection with this paper which have not been elsewhere authorized, authorization is hereby given to charge those fees to Deposit Account 18-0013 in the name of Rader, Fishman & Grauer PLLC. If the Examiner has any comments or suggestions which could place this application in even better form, the Examiner is requested to telephone the undersigned attorney at the number listed below.

Respectfully submitted,



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DATE OF DEPOSIT: January 3, 2005

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